

**REMARKS**

**I. Status of Claims**

Claims 1-30 are pending in this application.

In the last Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite, rejected claims 1-30 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter, and rejected claims 1-30 under 35 U.S.C. § 103(a) over International Publication No. WO 01/18674 ("*Maloney*").

**II. Rejection under 35 U.S.C. § 112, ¶ 1**

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite.

On page 3 of the Office Action, the Examiner asserts that claims 1-30 include a "beauty diagnostic" method, system, or computer product, and that it is allegedly not clear what the term "beauty" contemplates. Applicants respectfully disagree with the Examiner and submit that one skilled in the art would understand the meaning of claims 1-30 upon reading those claims. Further, definiteness of a claim must be analyzed, not in a vacuum, but in light of the content of the application disclosure. M.P.E.P.

§ 2173.02. As discussed in Applicants' specification, "beauty" refers to external body conditions and characteristics, including but not limited to skin, hair, nail, or other body conditions, or any other aesthetic-related, physical, physiological, or biological conditions of the user. Paragraphs [102] and [108] to [111] on pages 41, 42, 45, and 46 of the specification illustrate the meaning of "beauty" as it might relate to "beauty

diagnostic.” Accordingly, one skilled in the art would not find the term “beauty” vague or indefinite.

Hence, for at least the above reasons, the rejection of claims 1-30 under 35 U.S.C. § 112, ¶ 2 is without basis and should be withdrawn.

### **III. Rejection under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

On page 5 of the Office Action, the Examiner asserts that the inventions in claims 1-30 allegedly do not provide a “concrete result.” Specifically, the Examiner characterizes the claims as being allegedly “directed to nothing more than asking a subject personal questions,” and he further alleges that “the answers received for such types of questions are clearly subjective, and would differ from subject to subject, thereby providing no [indication] of concreteness of result.” *Office Action*, p. 5. These allegations are completely unsupported. For example, contrary to the Examiner’s allegations, even though certain claims include recitations relating to asking questions, the claims include many additional recitations. Moreover, Applicants point out that the Examiner has provided no evidence demonstrating that the answers to the questions are “clearly” subjective. Indeed, Applicants’ specification describes instances where the answers to questions may be objective, not subjective. For instance, by way of a non-limiting example, paragraph [028] on page 8 of the specification indicates that the answers may be about the subject’s physical characteristics, lifestyle, demographics, environment, sun exposure level, nutrition, medical history, cosmetic usage, or any

other information useful in evaluating the subject for a beauty product. Further, the subject's answers regarding her medical history may relate to a diagnosed condition affecting the external body, such as melanoma, which is based on objective information about the subject and is clearly not subjective. *Specification*, p. 8.

In addition, even if answers to the questions were to be at least partially subjective, the inventions in claims 1-30 provide a concrete result. For example, claim 1 recites:

1. A beauty diagnostic method, comprising:
  - asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;
  - receiving answers to the personal questions;
  - based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and
  - informing the subject about said at least one customized set of testing material.

Hence, the invention in claim 1 includes receiving answers to personal questions and selecting, based on the received answers, at least one customized set of testing material for determining quantitative information that would aid in recommending a beauty product to the subject. The selection of at least one customized set of testing material provides a concrete result. For example, as illustrated at paragraphs [064] to [068] on pages 26 and 27 of the specification, the selection may be done using a selection algorithm, a decision tree, a data base, or any other type of logic. In the case of a database, the selection algorithm may determine a set of individuals having

answers that closely resemble the subject's answers and select a customized set of testing material for the subject according to that set of individuals. Additionally, claim 1 includes informing the subject about the customized set of testing material, which has been selected based on the received answers. This information provided to the subject is a useful, tangible, and concrete result of claim 1.

By way of another example, claim 24 recites:

24. A beauty diagnostic method, comprising:

asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;

receiving answers to the personal questions;

based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject;

providing the subject with the customized set of testing material;

ascertaining the desired quantitative information by collecting data derived from use of the testing material on the subject; and

based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject.

Hence, the invention in claim 24 includes recommending at least one beauty product based on received answers and quantitative information ascertained by collecting data derived from use of testing material on the subject. This recommendation is a useful, tangible, and concrete result of claim 24.

For at least the above reasons, claims 1 and 24 are directed to statutory subject matter. Further, remaining claims 2-23 and 25-30 are also directed to statutory subject matter for reasons similar to the ones discussed above for claims 1 and 24, respectively. Accordingly, the rejection of claims 1-30 under 35 U.S.C. § 101 is without merit and should be withdrawn.

#### **IV. Rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 103(a) over *Maloney* because a prima facie case of obviousness has not been established.

With respect to claim 1, *Maloney* does not teach or suggest each and every element in the claim. Specifically, *Maloney* fails to teach or suggest “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject” and “informing the subject about said at least one customized set of testing material,” as recited in claim 1. *Maloney* merely discloses providing a customized product, such as a custom shampoo, to a consumer. *Maloney*, Abstract and p. 7. *Maloney* provides a test kit that “might comprise one or more tests” in order to collect profile data about a consumer to create the customized product. *Maloney*, p. 11. However, *Maloney*’s test kit is not a “customized set of testing material” selected from a plurality of testing materials based on received answers, as recited in claim 1. That is, providing a customized product, such as a custom shampoo, based on information from a standard test kit is not the

same as and does not suggest selecting a customized set of testing material from a plurality of testing materials based on received answers, for determining quantitative information that would aid in recommending at least one beauty product to the subject. Further, providing a customized product, such as a custom shampoo, based on information from a standard test kit is not the same as and does not suggest “informing the subject about said at least one customized set of testing material,” as recited in claim 1 (emphasis added).

Indeed, on page 6 of the Office Action, the Examiner appears to admit that *Maloney* does not disclose “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject,” as recited in claim 1. The Examiner then attempts to modify *Maloney* to yield the invention in claim 1. However, there is no evidence cited in the Office Action, providing any motivation to modify *Maloney* in the proposed manner.

For example, the Examiner alleges that

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Maloney* to indicate said “selecting” step includes selecting from a plurality of testing materials said at least customized set of testing materials, because it would advantageously allow to accommodate sub-categories of consumers, thereby providing each customer with said customized kit. *Office Action*, at 7.

However, the Office Action points to nothing in the prior art that teaches or suggests selecting a customized kit to “advantageously allow to accommodate sub-categories of

consumers." In an attempt to overcome *Maloney's* deficiencies, the Office Action merely presents a conclusory allegation unsupported by evidence.

Accordingly, for at least the above reasons, a *prima facie* case of obviousness has not been established for claim 1, and the rejection of claim 1 under 35 U.S.C. § 103(a) over *Maloney* should be withdrawn. The rejection of dependent claims 2-10 should also be withdrawn at least by virtue of their dependence upon allowable claim 1, in addition to the patentable subject matter contained therein.

Further, while claims 11-30 contain different scopes from claims 1-10, the rejection of claims 11-30 under 35 U.S.C. § 103(a) over *Maloney* should also be withdrawn for reasons similar to the ones discussed above for claims 1-10. In other words, the Office Action fails to set forth a *prima facie* case of obviousness for claims 11-30, especially in view of there being no motivation or suggestion to modify *Maloney* as proposed, and absolutely no support for the Examiner's allegations.

### **CONCLUSION**

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

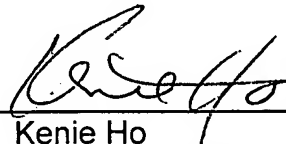
Applicants note that the Office Action contains numerous statements reflecting assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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